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EXAMINER

NGUYEN, THU HA T

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/541,378

Applicant(s)

ARNOLD, GREG

Examiner

Thu Ha T. Nguyen

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 are presented for examination.

Response to Arguments

Applicant's arguments filed on May 11, 2004 have been fully considered but they are not persuasive because of the following reasons:

2. Applicant argues that Markus teaches away from the embodiments of the instant invention by teaching a stand-alone computer, while the instant claimed invention teaches a palmtop computer and access forms from a file server for processing wireless queries and for interfacing between a palmtop computer system and the Internet wherein the palmtop computer accesses Internet resources using said file server as an intermediary. In response to Applicant's argument, examiner asserts that Markus discloses the processes presented in the invention may use with various general purpose computers (col. 18 lines 2-9, col. 20 lines 13-16). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made that **Markus** implicitly discloses a general computer equivalent to the palmtop computer as disclosed in the applicant's specification. A person of ordinary skill in the art would have recognized that **Markus** may uses/applies various types of computers in the invention to perform the same function in substantially the same way to reach substantially the same result as a palmtop computer. Further, in response to applicant's argue the limitation a file server for processing wireless queries and for interfacing between a palmtop computer system and the Internet wherein the palmtop computer accesses Internet resources using said file server as an intermediary.

Art Unit: 2155

Examiner concludes that in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the previous office action [paper no.4] examiner stated that Markus does not explicitly teach providing a file server for processing wireless queries and for serving as an interface between said palmtop computer system and the Internet wherein the palmtop computer utilizes Internet resources using said file server as an intermediary and receiving a wireless request from a palmtop computer.

However, Daswani teaches providing a server for processing wireless queries and for serving as an interface between said palmtop computer system and the Internet wherein the palmtop computer utilizes Internet resources using said file server as an intermediary and receiving a wireless request from a palmtop computer (abstract, figure 1, col. 3 lines 26-col. 4 lines 46, col. 6 lines 14-col. 8 lines 29, col. 14 lines 46-60). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teaching of Markus and Daswani to have a server for processing wireless queries and for serving as an interface between said palmtop computer system and the Internet wherein the palmtop computer utilizes Internet resources using said file server as an intermediary and receiving a wireless request from a palmtop computer because it would have an efficient communication system that provides server as an intermediate system to reduce time consuming and low latency connections for retrieving and providing Internet resources from Internet to

palmtop computers. Therefore, examiner concludes that Daswani does teach or suggest a server for processing wireless queries and for serving as an interface between said palmtop computer system and the Internet wherein the palmtop computer utilizes Internet resources using said file server as an intermediary.

3. Applicant argues that a file server that interfaces the palmtop computer with the Internet and provides the forms to the end computer system without the end computer system downloading the forms from the Internet. In response to Applicant's argument, Patent Office asserts that in the instant claimed language does not disclose or teach the end computer without downloading the forms from the Internet. Thus, it is unclear how the end computer connects to the file server (?). Markus teaches the end computer gets the electronic form documents from the file server by way of Internet or Intranet (col. 7, lines 24-29). Therefore, Patent Office concludes that Markus does teach the claimed limitations of the instant invention.

4. Applicant argues that Markus does not teach or suggest retrieving personal information data from the personal information database for fields mapped to the frame in the selected Web clipping in the site map database. In response to Applicant's argument, Patent Office asserts that Markus does teach retrieving personal information data from the personal information database for fields mapped to the frame in the selected Web clipping in the site map database as shown in figures 2-4, abstract, col. 5 lines 2-44, col. 7 lines 40-col. 8 lines 39.

5. Applicant argues that Rai does not teach wherein the palmtop computer accesses Internet resources using said file server as an intermediary. In response to

applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reason to combine the teaching of **Markus and Daswani** to have a file server configured to be an interface between said palmtop computer system and the Internet wherein the palmtop computer utilizes Internet resources using said file server as an intermediary and sending a wireless request from a palmtop computer because it would have an efficient communication system that provides server as an intermediate system to reduce time consuming and low latency connections for retrieving and providing Internet resources from Internet to palmtop computers and combine the teaching of **Markus and Rai** to have a palmtop computer, a radio frequency transmitter and radio receiver to transmit/receive request/response data because it would have an efficient mobility communication system to enhance convenient services for a wireless Internet access system.

Art Unit: 2155

7. As a result, cited prior arts do disclose and teach a system and method for providing transaction processing in a palmtop computer, as broadly claimed by the Applicant. Applicant clearly has still failed to identify specific claim limitations that would define a clearly patentable distinction over prior arts.

8. Therefore, the examiner asserts that cited prior art teaches or suggests the subject matter broadly recited in independent claims 1, 10, and 16. Claims 2-9, 11-15, and 17-20 are also rejected at least by virtue of their dependency on independent claims and by other reasons set forth in the office action below. Accordingly, claims 1-20 are rejected.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-8 and 10-14 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Markus et al.**, (hereinafter Markus) U.S. Patent No. **6,490,601**, in view of **Daswani et al.**, (hereinafter Daswani) U.S. Patent No. **6,477,565**.

11. As to claim 1, **Markus** teaches the invention substantially as claimed, including a method for providing transaction processing in a palmtop computer, comprising:

using a file server (figures 2-3);

storing a personal information database on the file server, that contains personal information data relating to a user of the palmtop computer (figures 2-3, abstract, col. 3 lines 52-col. 4 lines 20, col. 5 lines 2-44, col. 7 lines 1-col. 8 lines 64, col. 11 lines 63-col. 13 lines 9);

storing a site map database on the file server, that contains data which maps fields of the personal information database to frames of known Web clippings (col. 5 lines 2-44, col. 7 lines 39-col. 9 lines 18, col. 11 lines 63-col. 12 lines 36, col. 13 lines 49-col. 14 lines 29);

receiving a request from a palmtop computer to populate frames of a selected Web clipping (figures 2-3, col. 3 lines 52-col. 4 lines 20, col. 7 lines 24-62);

retrieving personal information data from the personal information database for fields mapped to the frame in the selected Web clipping in the site map database (figures 2-4, abstract, col. 5 lines 2-44, col. 7 lines 40-col. 8 lines 39); and

transmitting the retrieved personal information to the palmtop computer (abstract, figures 2-4, col. 7 lines 40-col. 8 lines 64).

Markus may not explicitly disclose the palmtop computer. However, **Markus** clearly states that the processes presented in the invention may use with various general purpose computers (col. 18 lines 2-9, col. 20 lines 13-16). It would have been

Art Unit: 2155

obvious to one of ordinary skill in the Data Processing art at the time of the invention was made that **Markus** implicitly discloses a general computer equivalent to the palmtop computer as disclosed in the applicant's specification. A person of ordinary skill in the art would have recognized that **Markus** may uses/applies various types of computers in the invention to perform the same function in substantially the same way to reach substantially the same result as a palmtop computer.

Markus does not explicitly teach providing a file server for processing wireless queries and interface between said palmtop computer system and the Internet wherein the palmtop computer accesses Internet resources using said file server as an intermediary and receiving a wireless request from a palmtop computer. However, **Daswani** teaches providing a server for processing wireless queries and interface between said palmtop computer system and the Internet wherein the palmtop computer accesses Internet resources using said file server as an intermediary and receiving a wireless request from a palmtop computer (abstract, figure 1, col. 3 lines 26-col. 4 lines 46, col. 6 lines 14-col. 8 lines 29, col. 14 lines 46-60). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teaching of **Markus and Daswani** to have a server for processing wireless queries and for serving as an interface between said palmtop computer system and the Internet wherein the palmtop computer utilizes Internet resources using said file server as an intermediary and receiving a wireless request from a palmtop computer because it would have an efficient communication system that provides server as an intermediate

Art Unit: 2155

system to reduce time consuming and low latency connections for retrieving and providing Internet resources from Internet to palmtop computers.

12. As to claim 2, **Markus** teaches the invention substantially as claimed, further comprising populating the frames of the selected Web clipping in the palmtop computer (figures 2-3, col. 3 lines 52-col. 4 lines 20, col. 7 lines 41-col. 8 lines 64).

13. As to claim 3, **Markus** teaches the invention substantially as claimed, further comprising transmitting the populated frame from the palmtop computer to a Web site (col. 7 lines 63-col. 8 lines 39, col. 11 lines 63-col. 12 lines 36).

14. As to claim 4, **Markus** teaches the invention substantially as claimed, wherein providing the site map includes scraping a Web site to harvest frames to be populated (figures 2-3, col. 3 lines 52-col. 4 lines 20, col. 8 lines 65-col. 9 lines 18).

15. As to claim 5, **Markus** teaches the invention substantially as claimed, wherein the personal information database is manually populated with data by the user (col. 12 lines 60-col. 13 lines 9).

16. As to claim 6, **Markus** teaches the invention substantially as claimed, wherein the server comprises a secure server (figures 2-3).

17. As to claim 7, **Markus** teaches the invention substantially as claimed, wherein the Web clipping correlates to a Web page on the World Wide Web (figures 2-3, col. 3 lines 52-65).

18. As to claim 8, **Markus** teaches the invention substantially as claimed, further comprising mapping the palmtop computer to a user in the personal information database (figures 2-3, col. 5 lines 2-44, col. 7 lines 40-col. 8 lines 39).

19. As to claim 10, **Markus** teaches the invention substantially as claimed, including a method for providing simplified transaction processing in a palmtop computer, comprising:

 sending a request from the palmtop computer to a file server to obtain information to populate a plurality of frames of a selected Web clipping (figures 2-3, col. 3 lines 52-col. 4 lines 20, col. 7 lines 24-62);

 receiving a transmission from the file server containing personal information data extracted from a personal information database, the personal information database residing on the file server, and containing personal information data relating to a user of the palmtop computer (figures 2-4, abstract, col. 5 lines 2-44, col. 7 lines 40-col. 8 lines 39);

 wherein, the personal information being retrieved from fields in the personal information database which have been mapped to frames in the selected Web clipping in the site map database (figures 2-3, abstract, col. 3 lines 52-col. 4 lines 20, col. 5 lines 2-44, col. 7 lines 1-col. 8 lines 64, col. 11 lines 63-col. 13 lines 9).

Art Unit: 2155

Markus may not explicitly disclose the palmtop computer. However, **Markus** clearly states that the processes presented in the invention may use with various general purpose computers (col. 18 lines 2-9, col. 20 lines 13-16). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made that **Markus** implicitly discloses a general computer equivalent to the palmtop computer as disclosed in the applicant's specification. A person of ordinary skill in the art would have recognized that **Markus** may uses/applies various types of computers in the invention to perform the same function in substantially the same way to reach substantially the same result as a palmtop computer.

Markus does not explicitly teach a file server configured to be an interface between said palmtop computer system and the Internet wherein the palmtop computer utilizes Internet resources using said file server as an intermediary and sending and receiving a wireless request from a palmtop computer. However, **Daswani** teaches a file server configured to be an interface between said palmtop computer system and the Internet wherein the palmtop computer utilizes Internet resources using said file server as an intermediary and sending and receiving a wireless request from a palmtop computer (abstract, figure 1, col. 3 lines 26-col. 4 lines 46, col. 6 lines 14-col. 8 lines 29, col. 14 lines 46-60). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teaching of **Markus and Daswani** to have a file server configured to be an interface between said palmtop computer system and the Internet wherein the palmtop computer utilizes Internet resources using said file server as an intermediary and sending and receiving a

Art Unit: 2155

wireless request from a palmtop computer because it would have an efficient communication system that provides server as an intermediate system to reduce time consuming and low latency connections for retrieving and providing Internet resources from Internet to palmtop computers.

20. As to claim 11, **Markus** teaches the invention substantially as claimed, further comprising transmitting the retrieved personal information to the palmtop computer (abstract, figures 2-4, col. 7 lines 40-col. 8 lines 64).

21. As to claim 12, **Markus** teaches the invention substantially as claimed, further comprising populating the frames of the selected Web clipping in the palmtop computer (figures 2-3, col. 3 lines 52-col. 4 lines 20, col. 7 lines 41-col. 8 lines 64).

22. As to claim 13, **Markus** teaches the invention substantially as claimed, further comprising transmitting the populated frames of the selected Web clipping to a Web site for transaction processing (figures 2-3, col. 7 lines 63-col. 8 lines 39, col. 11 lines 63-col. 12 lines 36).

23. As to claim 14, **Markus** teaches the invention substantially as claimed, wherein the populated frames of the selected Web clipping are transferred to the Web site through a data center which translates between Web clippings and Web pages (figures 2-3, col. 13 lines 49-col. 14 lines 29).

24. Claims 9, and 15-20 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Markus et al.**, (hereinafter Markus) U.S. Patent No. **6,490,601**, and **Rai et al.**, (hereinafter Rai) U.S. Patent No. **6,421,714**, further in view of **Daswani et al.**, (hereinafter Daswani) U.S. Patent No. **6,477,565**.

25. As to claim 9, **Markus** does not explicitly teach the receiving and transmitting are carried out over a wireless data communication network. However, **Rai** teaches the receiving and transmitting are carried out over a wireless data communication network (abstract, figures 1-2). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teaching of **Markus and Rai** to have the receiving and transmitting are carried out over a wireless data communication network because it would have an efficient mobility communication system to enhance convenient services for a wireless Internet access system.

26. As to claim 15, **Markus** does not explicitly teach the invention substantially as claimed; however, **Rai** teaches wherein the sending and receiving are carried out over a wireless data communication network (abstract, figures 1-2). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to have the same motivation as set forth in claim 9 above.

27. As to claim 16, **Markus** teaches the invention substantially as claimed, including a palmtop computer, comprising:

sending a request from the palmtop computer to a file server to obtain information to populate a plurality of frames of a selected Web clipping (figures 2-3, col. 3 lines 52-col. 4 lines 20, col. 7 lines 24-62);

receiving a transmission from the file server containing personal information data extracted from a personal information database, the personal information database residing on the file server, and containing personal information data relating to a user of the palmtop computer (figures 2-4, abstract, col. 5 lines 2-44, col. 7 lines 40-col. 8 lines 39); and

a processor which populates the frames of the selected Web clipping with the personal information data received (figures 2-3, abstract, col. 3 lines 52-col. 4 lines 20, col. 5 lines 2-44, col. 7 lines 1-col. 8 lines 64, col. 11 lines 63-col. 13 lines 9).

Markus may not explicitly disclose the palmtop computer, a radio frequency transmitter and a radio receiver. However, **Markus** clearly states that the processes presented in the invention may use with various general purpose computers (col. 18 lines 2-9, col. 20 lines 13-16). It would have been obvious that any wireless device have to have a radio frequency transmitter and radio receiver to transmit/receive request/response data. Moreover, **Rai** clearly teaches a radio frequency transmitter and a radio receiver for transmit/receive request/response data to and from wireless device and server (abstract, figures 2, 14, col. 5 lines 56-col. 6 lines 15). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the

invention was made to combine the teaching of **Markus and Rai** to have a palmtop computer, a radio frequency transmitter and radio receiver to transmit/receive request/response data because it would have an efficient mobility communication system to enhance convenient services for a wireless Internet access system.

Markus does not explicitly teach a file server configured to be an interface between said palmtop computer system and the Internet wherein the palmtop computer utilizes Internet resources using said file server as an intermediary and sending a wireless request from a palmtop computer. However, **Daswani** teaches a file server configured to be an interface between said palmtop computer system and the Internet wherein the palmtop computer utilizes Internet resources using said file server as an intermediary and sending a wireless request from a palmtop computer (abstract, figure 1, col. 3 lines 26-col. 4 lines 46, col. 6 lines 14-col. 8 lines 29, col. 14 lines 46-60). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention was made to combine the teaching of **Markus and Daswani** to have a file server configured to be an interface between said palmtop computer system and the Internet wherein the palmtop computer utilizes Internet resources using said file server as an intermediary and sending a wireless request from a palmtop computer because it would have an efficient communication system that provides server as an intermediate system to reduce time consuming and low latency connections for retrieving and providing Internet resources from Internet to palmtop computers.

28. As to claim 17, **Markus** teaches the invention substantially as claimed, wherein the request comprises a label for a Web clipping containing the frames to be populated (figures 2-3, col. 3 lines 52-col. 4 lines 20, col. 7 lines 41-col. 8 lines 64).

29. As to claim 18, **Markus** teaches the invention substantially as claimed, wherein the file server comprises a secure file server (figures 2-3).

30. As to claim 19, **Markus** teaches the invention substantially as claimed, further comprising means for transmitting the populated Web clipping to a Web site (col. 7 lines 63-col. 8 lines 39, col. 11 lines 63-col. 12 lines 36).

31. As to claim 20, **Markus** teaches the invention substantially as claimed, wherein the populated Web clipping is conveyed to the Web site through a data center containing the secure file server (figures 2-3, col. 7 lines 63-col. 8 lines 39, col. 11 lines 63-col. 12 lines 36, col. 13 lines 49-col. 14 lines 29).

Conclusion

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Ha Nguyen, whose telephone number is (703) 305-7447. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SPE Hosain T. Alam, can be reached at (703) 308-6662.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7240 for regular communications and 703-746-7238 for After Final communications.

Thu Ha Nguyen

August 13, 2004


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER